

REMARKS

Applicants appreciate the Examiner's thorough examination of the present application as evidenced by the Office Action of May 7, 2004 (hereinafter "Office Action"). Applicants especially appreciate the indication that Claims 8, 9, 33, 34, 55, and 56 recite patentable subject matter. Rather than writing various ones of the foregoing claims in independent form at this time, Applicants respectfully submit that the cited references are not properly combinable. Accordingly, Applicants submit that all pending claims are in condition for allowance. Favorable reconsideration of all pending claims is respectfully requested for at least the reasons discussed hereafter.

Independent Claims 1, 10, 23, 26, 35, 48, and 57 are Patentable

Independent Claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over the document entitled "Webhire Links Corporate Recruiting Desktops to Over 2,000 Job Posting Sites," March 2, 2000 (hereinafter "Webhire") in view of U. S. Patent No. 4,910,60 to Li (hereinafter "Li").

Independent Claim 1 is directed to a method of selecting a job post site and has been reproduced below:

- obtaining at least one job post site selection criterion;
- automatically ranking a plurality of job post sites based on the at least one job post site selection criterion, comprising:
 - accessing a fact table that contains data relevant to the at least one job post site selection criterion; and
 - using an inference engine to process the at least one job post site selection criterion and the fact table to rank the plurality of job post sites based on the at least one job post site selection criterion; and
 - selecting the job post site from the plurality of job post sites based on the ranking of the plurality of job post sites.

Claims 10, 23, 26, 35, 48, and 57 include similar recitations. Thus, according to the recitations of the pending independent claims, a plurality of job post sites are automatically ranked based on at least one job post site selection criterion by accessing a fact table that contains data relevant to the at least one job post site selection criterion and by using an inference engine to process the at least one job post site selection criterion and the fact table to rank the plurality of job post sites based on

the at least one job post site selection criterion.

The Office Action acknowledges that Webhire does not teach or suggest the recitations directed to automatically ranking a plurality of job post sites, accessing a fact table, and using an inference engine. (Office Action, page 4). The Office Action does allege, however, that Li provides the missing teachings. Applicants respectfully submit, however, that neither Webhire nor Li include any motivation or suggestion to modify Webhire as indicated in the Office Action.

To establish a *prima facie* case of obviousness, the prior art reference must teach or suggest *all* the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. M.P.E.P. § 2143. The mere fact that references **can be modified** does not render the resultant combination obvious **unless the prior art also suggests the desirability of the modification**. M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). There is no motivation or suggestion to modify the cited reference as suggested in the Office Action. As affirmed by the Court of Appeals for the Federal Circuit in *In re Sang-su Lee*, a factual question of motivation is material to patentability, **and cannot be resolved on subjective belief and unknown authority**. See *In re Sang-su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to modify the reference, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983).

Li is directed to a self-optimization method and machine. Applicants submit that nothing in Webhire or Li provides any motivation to modify Webhire to include Li's self-optimization techniques because such techniques would appear to detract from Webhire's job posting system rather than improve or enhance it. For example, Li states that an object of his invention "is to provide real-time self-optimizing machine and method capable of handling tens, hundreds, thousands, or more variables with **no or minimum human guidance...**" (Li, col. 3, lines 19 - 22; emphasis added). Furthermore, Li explains that "[t]o fully utilize my self-optimizing machine, however, these 'rules' are preferably instantly and automatically implemented through actuators **without introducing any delays or errors due to the presence of humans in the loops.**"

(Li, col. 7, lines 62 - 66; emphasis added). Thus, Li's self-optimization method and machine is designed to work without human intervention.

Applicants respectfully submit, however, that if Webhire's job posting system were to be modified to incorporate an expert system, then such an expert system would be built and modified based on human feedback and data. That is, information on whether a particular job post site has been successful for a recruiter would likely be provided by interviewing a person responsible for recruiting and finding out which job post sites provided the best candidates for a particular job or jobs. Thus, Applicants submit that there would be no motivation to modify Webhire's job posting system with Li's self-optimization method and machine, which is designed for real-time systems that do not incorporate human feedback.

Accordingly, for at least the foregoing reasons, Applicants respectfully submit that independent Claims 1, 10, 23, 26, 35, 48, and 57 are patentable over Webhire and that Claims 3 - 9, 11 - 14, 16 - 22, 25, 28 - 34, 36 - 39, 41 - 47, 50 - 56, 58 - 61, 63 - 69 are patentable at least per the patentability of independent Claims 1, 10, 23, 26, 35, 48, and 57.

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CONCLUSION

In light of the above amendments and remarks, Applicants respectfully submit that the above-entitled application is now in condition for allowance. Favorable reconsideration of this application, as amended, is respectfully requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (919) 854-1400.

Respectfully submitted,

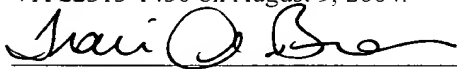


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